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09/270,461	03/15/1999	JONATHAN D. BUCKLEY		2532

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EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT	PAPER NUMBER
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2635

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/270,461
Filing Date: March 15, 1999
Appellant(s): BUCKLEY ET AL.

MAILED

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GROUP 2600

Thomas H. Jenkins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 3/25/2005 appealing from the
Office action mailed on 4/23/2004.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Regarding appellant's argument (line 16, page 11 to line 12, page 12 in the Appeal Brief), the examiner withdraws rejection under 35 USC § 112, First Paragraph in view of evidence provided by the appellant.

Regarding appellant's argument (sections II.A, II.B, II.C, II.D, II.E, II.G and II.J, pages 13-21 and 26-27 in the Appeal Brief), the examiner withdraws rejection under 35 USC § 135 (b) in view of evidence provided by the appellant.

Regarding appellant's argument (sections II.F, II.H and II.I in the Appeal Brief), the examiner maintains rejection under 35 USC § 135 (b).

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Regarding appellant's argument (section III, page 27 in the Appeal Brief), the examiner maintains rejection under 35 USC § 135 (b).

Therefore, the grounds of rejection to be reviewed on Appeal are:

- I. Claims 25-29 were rejected under 35 U.S.C. 135(b) on the ground that the claims were not made prior to one year from the issue date of the '039 patent; and
- II. Claims 25-29 were rejected under 35 U.S.C. 102 (e) on the ground that they are anticipated by the '039 patent.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,293,039

Fuchs

9-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(1). *Claim Rejections – 35 USC § 135(b)*

Claims 25-29 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 6,293,039 was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.

Claims 1-5 (US 6,293,039) are not the same as claims 1-14 originally filed in application (appl.-09/270461) as shown below:

"notch" in claim 2 (US 6,293,039) is not the same as an "aperture" in claim 5 (appl.-09/270461) as originally filed within one year of the patent date. Notch refers to a cut in to an object and an aperture is a hole.

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“a plurality of display elements” in claim 1 (US 6,293,039) was not claimed in appl.-09/270461 as originally filed within one year of the patent date.

All of the limitations of Claims 3 and 5 (US 6,293,039) were not claimed in appl.-09/270461 within one year of the patent date.

(2).

Claim Rejections – 35 USC § 102

Claims 25–29 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuchs (6,293,039).

Regarding claim 25, Fuchs teaches a pistol having a locking mechanism configured to lock a trigger mechanism of the pistol if an attempt is made by an unauthorized person to fire the pistol, the locking mechanism comprising: an identification unit configured to detect an identification signal imputed into the identification unit; a control unit connected to the identification unit, the control unit configured to compare the signal inputted into the identification unit with a stored identification code; an actuator device including a geared motor connected to the control unit and connected by a threaded spindle and nut connection with a mechanical locking element which is movable between a locked position an unlocked position, wherein in the locked position the locking element locks a trigger tongue of the pistol; a battery for supplying electrical power to the locking mechanism; and a plurality of display elements configured to display an operating status of the locking mechanism (claim 1).

Regarding claim 26, Fuchs teaches a pistol as claimed in claim 25, wherein the locking element is configured to engage a notch in the trigger tongue, and wherein the locking element is guided for movement in a bolt and is spring-loaded (claim 2).

Regarding claim 27, Fuchs teaches a pistol as claimed in claim 25, wherein at least the greater portion of the locking mechanism is located in front of a trigger guard and below the barrel of the pistol (claim 3).

Regarding claim 28, Fuchs teaches a pistol as claimed in claim 25, wherein the identification unit comprises a keypad for the input of the code (claim 4).

Regarding claim 29, Fuchs teaches a pistol as claimed in claim 25, wherein the identification unit comprises a fingerprint scanner (claim 5).

(10) Response to Argument

Regarding appellant's argument (sections II.F, II.H and II.I in the Appeal Brief), the examiner maintains rejection under 35 USC § 135 (b) as follows:

Regarding appellant's argument (section II.F (pages 19–20) in the Appeal Brief), the appellant argues that there is no 'material' difference between a notch and an aperture and specification refers to them interchangeably. It is examiner's position that they are not the same. The examiner maintains that "Notch" in claim 2 (US 6,293,039) is associated with cut-across the trigger (as shown in Figs. 2–3 as element 50 in figures) and "Aperture" in claim 5 is associated with hole in the trigger (as shown in fig. 5 of appl.–09/270,461). Clearly one skilled in the art recognizes the function of these two configurations is different with respect restraining wherein "Notch" provides restraining along one dimension and "Aperture" claimed in claim 5 (appl.–09/270461) provides restraining in two dimensions.

Regarding appellant's argument (section II.H (page 22) in the Appeal Brief), the appellant argues that the prosecution of the '039 patent confirms that the display element limitation is not material to the claimed invention. This limitation appeared in the claims of the ,039 patent when the application was filed, and it was never argued to be a basis for patentability. However, it is the examiner's position that just because the element is known, is not evidence to suggest the element is not material to the invention. The fact that the "plurality of display elements" are claimed in conjunction with the locking mechanism in the patent in order to show the status of the locking mechanism is material to the claimed invention.

Regarding appellant's argument (section II.I (page 25) in the Appeal Brief), the appellant argues when considering means plus function that blocking means are located in front of the trigger guard and below the barrel as shown in figures 1–2. It is examiner's position that this argument is not persuasive. Means plus function does not encompass location. Rather means plus function language is defined by the structure disclosed. Furthermore, with respect to appellant's application blocking means defined by figure 3 includes all of the elements of figure 4. When considering this with respect to fig. 2, clearly the greater portion of blocking means (elements 38, 40, 42,44,60,54) is not in front of the trigger guard. Furthermore, regarding appellant's argument (section II.I (page 25) in the Appeal Brief), the appellant argues that a fingerprint reader associated biometric device is claimed in claim 5. However, the examiner maintains that fingerprint reader is not same as fingerprint scanner

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wherein fingerprint reader collects image data of the finger or some data associated with finger (can be done many ways other than scanning) and fingerprint scanner merely scans the finger. Therefore, a fingerprint scanner is not claimed in claim 29 (claim 5).

Regarding appellant's argument (section III, page 27 in the Appeal Brief), the examiner maintains that since claims 1-5 (US 6,293,039) are not the same as claims 1-14 originally filed in application (appl.-09/270461) as shown below, claims 25-29 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 6,293,039 was granted. Therefore, claims 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuchs (6,293,039) as provided below.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Matsuichiro Shimizu

October 20, 2005

Conferees: Michael Horabik (SPE) and Brian Zimmerman (PE)


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